

REMARKS

This responds to the Office Action mailed on January 5, 2009. Claims 1 and 12 are amended, and claims 16-20 are added; as a result, claims 1-20 are now pending in this application.

§ 112 Rejection of the Claims

Claims 12-15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant herein presents amendments to claim 12 to recite "the starting point in the past containing a television program or a part of the television program prior to the time value of a current time," which clearly defines the starting point consistent with the originally filed specification and figures. Applicant respectfully requests withdrawal of this rejection.

§ 102 Rejection of the Claims

Claims 1-3 and 5-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Candelore (U.S. Patent No. 6,363,149).

A) *The Applicable Law for Rejections under 35 U.S.C. § 102*

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.² The identical invention must be shown in as complete detail as is contained in the claim.³

¹ M.P.E.P. § 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996).

³ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

B) *The rejection of claims 1-3 and 5-15 under 35 U.S.C. § 102(b) as being anticipated by Candelore is improper.*

Claims 1-3 and 5-15 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Candelore. Because a proper *prima facie* case of anticipation has not been properly established by the Office, the Applicant respectfully traverses. Applicant respectfully submits that Candelore does not disclose each and every element as set forth in Applicant's claim 1, and therefore does not anticipate Applicant's claim 1, which recites:

1. A method of distributing units of encrypted information and providing conditional access to the units, using a secure device capable of selectively enabling decryption of said units, the method comprising:

distributing a stream comprising the units of information successively, the stream including a plurality of entitlement control messages, wherein *each of the entitlement control messages is linked to a respective time-stamp, the respective time stamp associated with a time-stamp value indicative of a time at which the entitlement control message linked to the time-stamp was distributed*; and sending an entitlement management message to the secure device, the *entitlement management message including a specification of a range of time-stamp values and entitling the secure device to enable decryption of the units of information that are linked to time-stamps with time stamp values in that range*, wherein the range initially has a starting point prior to a time value corresponding to when the entitlement management message is sent. (*Emphasis added.*)

Specifically, the elements of claim 1 require that *each of the entitlement control messages linked to a respective time-stamp, the respective time stamp associated with a time-stamp value indicative of a time at which the entitlement control message linked to the time-stamp was distributed*. And further that the *entitlement message including a specification of a range of*

time-stamp values and entitling the secure device to enable decryption of the units of information that are linked to time-stamps with time stamp values in that range.

As detailed in Applicant's specification, the entitlement management message (EMM) specifies a range of time values for which decryption of parts of the data stream is enabled.⁴ Each data stream contains encrypted content, encryption control messages (ECMs) and EMMs.⁵ The system compares the time-stamp to the specified range of the EMM⁶. Decryption is enabled as long as the time stamp of the ECM corresponds to a time value within the time range.⁷

In contrast to Applicant's claim 1, Candelore does NOT teach a system, wherein *each of the entitlement control messages is linked to a respective time-stamp, the respective time stamp associated with a time-stamp value indicative of a time at which the entitlement control message linked to the time-stamp was distributed*. Applicant respectfully disagrees with the Examiner's characterization of Candelore's Fig. 6B, as teaching such a time-stamp. In Candelore, the time X is identified. The time, X, does not correspond to a time at which the ECM *was distributed*, but rather corresponds to a current and future "time epochs."⁸ The time epoch of Candelore is a period of time corresponding to an authorization period, such as a monthly epoch basis.⁹ The time epoch is not a time when the ECM was broadcast. Further, the ECM fields of FIG. 6B are used to provide future access keys, wherein "time X is the current key epoch, while time X-1 is the next epoch."¹⁰ In other words, the structure of FIG. 6B allows specification of a year's worth of monthly key information.

Still further, Candelore does not teach the elements of Applicant's claims and actually teaches an alternative solution by providing time epoch information in the ECMs. The system does not check time information of the ECM to a time range specified by an EMM. In fact,

⁴ Applicant's specification, page 2, lines 20-21.

⁵ Ibid., page 5, lines 10-12.

⁶ Ibid., page 7, lines 4-6.

⁷ Ibid., page 6, lines 24-31.

⁸ Candelore, col. 10, lines 43-54.

⁹ Ibid., col. 10, lines 50-51.

¹⁰ Ibid., col. 10, lines 33-34 and 48-54.

Candelore does not even mention time stamps. According to the Candelore system, the ECM "contains a key that corresponds to a given time period,"¹¹ but does not teach a time-stamp. According to the Candelore system, the EMM merely delivers privileges and rights to the receiver.¹² There is no need for the ECM to include a *timestamp indicative of a time at which the entitlement control message ... was distributed*, as the ECM of Candelore identifies a time period during which the key is valid, which is then used to apply the privileges designated by the EMM. This is in contrast to the system of Applicant's claims, wherein the ECM time-stamp is compared to a time range indicated in the EMM. In fact, there is no need or reason for Candelore to send an EMM having a *specification of a range of time-stamp values*, as time information is provided by the ECM.

Further in contrast to Applicant's claim 1, Candelore does NOT teach a system having an EMM as recited in Applicant's claims. Candelore does not teach or suggest that an EMM enables *decryption of the units of information that are linked to time-stamps with time stamp values in that range*, as the EMM of Candelore does not include a specification of a range of time-stamp values. As discussed hereinabove, Candelore does not teach time-stamps. In addition, the specific operation of the EMM in Candelore is only briefly discussed and is not taught in detail. Therefore, any specifics as to the function and content of the EMM are made by assumptions; in making such assumptions, the Examiner employed impermissible hindsight having seen Applicant's claimed invention. In addition, any such assumptions misinterpret the function and coordination of the ECM and EMM of Candelore. Candelore only discusses time period information provided by the ECM, and there is no support for time information supplied by the EMM.

The arguments provided with respect to claim 1 are also applicable to independent claim 10 and claims depending on claims 1 and 10. Applicant respectfully submits that Candelore fails to anticipate the pending claims and respectfully requests withdrawal of these rejections.

¹¹ Candelore, col. 10, lines 46-48 and lines 60-61.

¹² Ibid., col. 4, lines 24-34.

§ 103 Rejection of the Claims

Claim 4 was rejected under 35 U.S.C. § 103(a) as being obvious over Candelore and further in view of Thexton et al. (U.S. Patent No. 6,772,435; hereinafter "Thexton").

A) *The Applicable Law for Rejections under 35 U.S.C. § 103.*

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The KSR Court further held that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007)).

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. (*Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985).) The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. (*In re Bond*, 910 F.2d 831,834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).) Critical differences in the prior art must be recognized (when

attempting to combine references). (*In re Bond*, 910 F.2d 831,834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).)

Moreover, the fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. (*Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990).) When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. (*Id.* at 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966).)

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The CCPA has also noted that "[t]he court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings." *In re Spinnoble*, 160 USPQ 237, 243 (CCPA 1969). These principles have not been changed by the ruling in *KSR*.

B) The rejection of claim 4 under 35 U.S.C. § 103(a) as being obvious over Candalore in view of Thexton is improper.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Candalore in view of Thexton. Because a proper *prima facie* case of obviousness has not been properly established by the Office, the Applicant respectfully traverses.

The arguments provided hereinabove with respect to claim 1 are also applicable to claim 4. The Examiner further admits that Candalore fails to disclose *a secure device that maintains and updates a current time value corresponding to the time values of the time stamps as they are distributed as a function of time.*¹³ Applicant respectfully disagrees with the Examiner's characterization of Candalore in view of Thexton as teaching Applicant's claimed invention. First, the teachings of Thexton do not satisfy the deficiencies of Candalore, and therefore the

¹³ Office Action, page 10.

combination of Thexton and Candelore do not teach the elements of the independent claim on which claim 4 depends. Still further, Thexton does not teach or suggest a *time-stamp*, and does not teach *a secure device that maintains and updates* a time value corresponding to *a time-stamp*. As a result, the applied references fail to teach each and every limitation of the claim; and the applied references do not solve the problem addressed by Applicant's claim, specifically to provide a type of subscription enables a subscriber to view stored information which has been broadcast in the past.

As a proper *prima facie* case of obviousness has not been properly established by the Office, the Applicant respectfully requests withdrawal of this rejection.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6900 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 6, 2009.

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